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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/521,287

08/08/2005

Manabu Sutoh

71,051-001

8510

27305

7590

03/18/2008

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EXAMINER

LOEWE, ROBERT S

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

03/18/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/521,287 | <b>Applicant(s)</b><br>SUTOH ET AL. |  |
|                              | <b>Examiner</b><br>ROBERT LOEWE      | <b>Art Unit</b><br>1796             |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 11-34 is/are pending in the application.
- 4a) Of the above claim(s) 11-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION*****Claim Interpretation***

The phrase "silicone-based adhesive sheet" can be interpreted as any adhesive comprising a silicone layer. Stated differently, if an adhesive sheet comprises one or more silicone layers, it can be considered a silicone-based adhesive sheet, even if the silicone layers are not employed as the adhesive layer. Second, a silicone-based adhesive sheet having two different silicone layers present can be interpreted as a silicone-based adhesive wherein one silicone layer has a slower curing rate than the other. It is the position of the Examiner that two different curable silicone compositions will inherently have different curing rates, thus one of the two systems will have a slower curing rate than the other.

Last, in regards to instant claim 5, it is the position of the Examiner that any layer which is applied on top of the silicone layer would thus serve as a protective layer, even if the top layer (overcoat) is not meant to be a protective layer. The physical presence of a top layer is inherently capable of providing a certain degree of protection (no matter how small) to the underlying silicone layer.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3 and 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Delcuve et al. (US Pat. 5,658,629).

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Delcuve et al. teaches a double-sided silicone coated layer wherein an adhesive layer is sandwiched between the silicone layer and the carrier (abstract). Again, in light of the claim interpretation above, Delcuve et al. inherently teaches a silicone-based adhesive sheet. Delcuve et al. further teaches that there are two silicone layers on opposite sides of the liner (see for example, Figure 10, **2** = liner; **3** and **5** = clay coating on liner; **6** and **8** = silicone layer). Delcuve et al. further teaches that the silicone layers may be different (3:33-39). In light of the claim interpretation above, it can be assumed that different silicone layers inherently possess different curing rates, thus, one silicone layer has a slower curing rate than the other. Thus, Delcuve et al. anticipates all of the limitations of instant claim 1.

Claim 3: Delcuve et al. further teaches that the silicone coating layers can be of the hydrosilation curing type (examples 1 and 2).

Claim 4: Delcuve et al. further teaches several silicone layer compositions in examples 1 and 2. Said examples include such hydrosilation-curable silicone compositions comprising polysiloxanes having alkenyl groups, fillers, organohydrogenpolysiloxanes, adhesion promoters and catalyst (examples 1 and 2).

Claim 5: Delcuve et al. further teaches an adhesive layer which is applied to one of the silicone layers (see for example, Figure 10, **12** = adhesive layer).

Claim 6: Delcuve et al. further teaches that the silicone layers are cured (examples 1 and 2).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Delcuve et al. (US Pat. 5,658,629), as applied to claims 1 and 3 above.

Delcuve et al. teaches a silicone-based adhesive sheet according to instant claim 1, as described above. Delcuve et al. further teaches that the silicone layer can be cured via hydrosilation according to instant claim 3, as described above. Delcuve et al. does not explicitly teach that the hydrosilation curable silicone layer(s) have a plasticity number of between 100 to 800, as specified by JIS K 6249. However, Delcuve et al. teaches substantially similar curable silicone compositions as the instant application. It

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follows that Delcuve et al. implicitly teaches that the curable silicone materials have a plasticity number of between 100 to 800, as specified by JIS K 6249. The compositions taught by Delcuve et al. is further expected to have plasticity values which fall into the range of instant claim 2 since the instant application is not stringent in the types and structures of the components typically present in a curable silicone composition which is curable via hydrosilation, and the plasticity number of 100 to 800 represents a very wide range.

#### ***Relevant Art Cited***

The prior art made of record and not relied upon but is considered pertinent to applicants disclosure can be found on the attached PTO-892 form.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Loewe whose telephone number is (571) 270-3298. The examiner can normally be reached on Monday through Friday from 5:30 AM to 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L./  
Examiner, Art Unit 1796  
12-Mar-08

/Randy Gulakowski/  
Supervisory Patent Examiner, Art Unit 1796